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IN THE

Supreme Court of the United States

No. [illegible] 31 October Term, 1934.

G. S. ROGERS, doing business as REX DUPLEX FITTING COMPANY, and R. W. DUSENBERRY,

Petitioners,

v.

ALEMITE CORPORATION,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

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No. October Term, 1934.

G. S. Rogers, doing business as Rex Duplex Fitting Company, and R. W. Dusenberry
Petitioners,

v.

Alemite Corporation,
Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, G. S. Rogers (doing business as Rex Duplex Fitting Company), and R. W. Dusenberry, pray for a writ of certiorari to the United States Circuit Court of Appeals for the Third Circuit, to review a judgment of that Court entered December 18, 1934, and in which a petition for rehearing was denied on January 25, 1935.

A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with Rule 38 of the Rules of this Court.

SUMMARY AND SHORT STATEMENT OF MATTER INVOLVED.

The present suit was brought in the United States District Court in and for the Western District of Pennsylvania, by the Alemite Corporation, as plaintiff, against G. S. Rogers (doing business as Rex Duplex Fitting Company) and R. W. Dusenberry, and R. H. Kidd,* as defendants, on Gullborg Patent No. 1,307,734 (granted June 24, 1919), based upon **two** separate and distinct, and specifically **different** charges of *contributory* infringement;—both charges of contributory infringement predicated however upon generically similar factual situations and upon the **same legal contention.**

The Disclosure of the Patent in Suit.

The patent in suit (No. 1,307,734) discloses **two** separate and distinct mechanical devices each having* a separate and independent status in the art of lubrication, and the two devices having been* customarily used in conjunction with each other; the relationship between these two devices being merely that each device constitutes the (broadly) old environment in which the other device is customarily used (much the same as an incandescent electric bulb or lamp is used with an electric socket, or an electric socket used with an electric bulb).

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* R. H. Kidd withdrew as a defendant prior to trial; and upon order of Court the bill of complaint was taken **pro confesso** against him. For this reason, the final decree of the District Court (R., p. 184) does not include said R. H. Kidd, and said R. H. Kidd took no part in the appeal to the Circuit Court of Appeals.

* At all times prior to the application for the patent in suit.

The Two Devices of the Patent in Suit.

The "Grease-Gun" 1) On one hand, the patent in suit discloses a broadly **old** lubricant-dispensing device, sometimes generally referred to as a "grease-gun," comprising an **old** pump (or compressor), an **old** hose and an **old** "bayonet" type hose-coupler on the end of the hose; whereby temporary and quick-detachable connection may be made between the end of the grease-gun hose and any one of a plurality of **old** or new "bayonet" type grease-cups (or "pin-fittings") on an automobile or other machine, or on many automobiles or machines;—the otherwise **old** "bayonet" type hose-coupler of the patent in suit having certain allegedly new and useful details of construction whereby a slight vacuum or suction is claimed to be produced within the coupler at the instant of disunion from **any** "bayonet" type grease-cup or "pin-fitting," and which alleged "suction-effect" is supposed to be conducive to greater cleanliness in the use of the grease-gun by sucking back into the hose-coupler any slight excess of grease that may otherwise exude or drip out at the instant of disunion.

The "Grease-Cup" 2) On the other hand, the patent in suit discloses a broadly **old** and unpatented "bayonet" type grease-cup or so-called "pin-fitting," comprising a small tubular body and having bayonet lugs or a bayonet-pin projecting from its two sides for the reception of **any old** or new "bayonet" type hose-coupler of **any old** or new grease-gun, and having a spring-pressed check valve or closure valve;—the asserted novelty of this "bayonet" type grease-cup or "pin-fitting" being the specific disposition of the valve-closing spring between the closure-valve and the bayonet-pin (which latter extends through the tubular body of the grease-cup) whereby the bayonet-pin

may not only serve its normal function as a bayonet-pin, but may also at the same time act as a spring abutment on the inside of the grease-cup for giving support to the valve-closing spring. The grease-cup or "pin-fitting," of the patent in suit constitutes, per se, the subject-matter of plaintiff's earlier-filed Patent No. 1,307,733 **not** in suit (R., pp. 245-247), which contains claims addressed to precisely this asserted novelty of plaintiff's grease-cup or "pin-fitting" invention.

The Claims of the Patent in Suit.

Hose-Coupler **not** claimed.

The patent in suit does **not** claim the so-called "suction-effect" hose-coupler, per se, because even the specific structural features or elements in the coupler (which give rise to this alleged "suction-effect") were admittedly old in bayonet type hose-couplers per se, and because the asserted utility and novelty of this "suction-effect" was in an alleged "combination" of that hose-coupler with a grease pump, a hose, and a grease-cup.

Grease-gun **not** claimed.

The patent in suit likewise does **not** claim what may be termed a "suction-effect" grease-gun, that is, a grease-gun comprising the old pump, the old hose and the "suction-effect," hose-coupler (the pump, hose and coupler being sometimes referred to as the "grease-gun").

Grease-cup **not** claimed.

The patent in suit does **not** claim the grease-cup or "pin-fitting" per se, because plaintiff, apparently recognizing the separate and independent status of grease-guns on one hand and grease-cups on the other hand, took out a

separate and independent Patent No. 1,307,733 (**not** in issue) claiming this grease-cup or pin-fitting, per se, with its alleged novel disposition of the valve-closing spring between the valve-closure and the bayonet-pin.

The alleged "combination" claimed.

All the claims of the patent in suit declared upon (as well as those not in issue) recite in each instance, an alleged "combination" of the **four** separate and distinct mechanical devices which have always* been used in conjunction with each other for the lubrication of machinery, to wit: (1) a pump; (2) a hose; (3) a hose-coupler; and (4) a grease-cup.†

The claims of the patent in suit declared upon are divisible into two groups, to wit:

1. Claims 1, 2, 3, 4 and 8 reciting in detail plaintiff's specific "suction-effect" hose-coupler in "combination" with **any** (old or new) pump, hose, and grease-cup (the pump, hose and grease-cup being merely generically defined in these claims)

and

2. Claims 14 and 15 reciting in detail plaintiff's specific internal construction in "bayonet" type grease-cups (which is claimed, per se, in plaintiff's "pin-fitting" Patent No. 1,307,733 not in suit), in "combination" with **any** (old or new) pump, hose and bayonet type hose-coupler (the pump, hose and hose-coupler being merely generically defined in these claims).

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* Long prior to the filing of the application for the patent in suit.

† Some of the claims, such as Claim 8, for instance, also generically recite (in "combination") the apparatus to be lubricated, as, for instance, the automobile or other machine.

DEFENDANTS' ACCUSED DEVICES.

Defendants manufactured and sold **two** separate and distinct **devices,** each having a separate and independent status in the art of lubrication, to wit:

1) admittedly **old** and **un**patented lubricant-dispensing pumps or so-called "grease-guns," having admittedly **old** and **un**patented "bayonet" type hose-couplers at the free ends of their discharge hoses,

adapted to be connected onto and to force lubricant into any **old** and **un**patented "bayonet" type grease-cups or so-called "pin-fittings," as, for instance, defendants' (and others') **old** and **un**patented grease-cups or "pin-fittings" referred to in sub-section 2 hereinbelow,

or

adapted to be connected onto (and to force lubricant into) any alleged new and patented grease-cups or "pin-fittings" such as plaintiff's "pin-fittings" disclosed (but not claimed) in its patent in suit and claimed (per se) in its other Gullborg Patent No. 1,307,733, **not** in suit.

2) admittedly old and unpatented grease-cups having "bayonet" lugs or "pins" projecting from its sides, for coupling engagement

by any **old** and **un**patented "bayonet" type hose-coupler part of any old and unpatented lubricant-dispensing pump or "grease-gun," as, for instance, defendants' (and others') **old** and **un**patented "grease-guns" referred to in sub-section 1 hereinabove,

or

by any allegedly new, improved and patentable

"bayonet" type hose-coupler part of an old grease-gun, such as plaintiff's so-called "suction-effect" bayonet hose-couplers of the patent-in-suit, with which plaintiff's admittedly **old** grease pumps are equipped.

THE CHARGES OF INFRINGEMENT.

Plaintiff has **not** charged **any*** infringement of its "suction-effect" claims or its coupler-defining claims (1, 2, 3, 4, and 8), either by reason of defendants' grease-gun (which may be regarded as comprising a pump, hose, and hose-coupler), or by reason of defendants' hose-coupler per se;—plaintiff thereby conceding the fact that neither defendants' "grease-guns" nor the defendants' hose-coupler, per se, has the so-called "suction-effect" or the structural features allegedly giving rise to such "suctional-effect," and that defendants' grease-gun is admittedly what in this litigation may be termed as the old "**non**suctioned-effect" type or kind of grease-gun.

Plaintiff has likewise **not** charged **any*** infringement of its "pin-fitting" claims or "pin-fitting" defining claims (14 and 15), by reason of defendants' manufacture and sale of the accused "pin-fittings";—plaintiff thereby conceding that defendants' "pin-fitting" is devoid of the structural features which are specifically recited in the "pin-fitting" defining *portions* of these claims (14 and 15).

Each of the **two** separate and distinct charges of infringement in this suit are charges of *contributory* infringement (as distinguished from direct infringement):

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* Either direct infringement or contributory infringement.

* Either direct infringement or contributory infringement.

1. *Contributory* infringement of the "suction-effect" claims (1, 2, 3, 4, and 8) is charged by reason of defendants' manufacture and sale of their **old** and **un**patented grease-cups or "pin-fittings," upon the assertion that the same are adapted and intended to have attached to them and to have lubricant forced into them by, *inter alia,* plaintiff's "suction-effect" grease-guns, that is, having the so-called "suction-effect" hose-coupler, specifically defined by these claims in "combination" with **any old** grease pump, hose, and **any old** bayonet type grease-cup or "pin-fitting";—and notwithstanding that defendants' accused (old and unpatented) grease-cups or "pin-fittings" are also adapted and intended to have attached to them and to have lubricant forced into them by "**non**suction-effect" hose-couplers or "**non**suction-effect" grease-guns manufactured and sold by defendants (and others).

2. *Contributory* infringement of the "pin-fitting" claims (14 and 15) is charged by reason of defendants' manufacture and sale of their **old** and **un**patented ("**non**suctional") grease-guns, upon the assertion that the same are adapted and intended to be connected onto and to force lubricant into (*inter alia*), plaintiff's grease-cups or "pin-fittings" defined in detail in these claims;—and notwithstanding that defendants' accused **old** and **un**patented grease-guns are also adapted and intended to be connected onto and to force lubricant into other non-infringing "pin-fittings" manufactured and sold by defendants (and others).

THE COMMERCIAL SITUATION.

Pin-fittings on one hand and grease-guns on the other hand (the latter comprising a pump, a hose and a hose-coupler) were old in the art, as was the combination of pin-fitting and grease-gun (see *Lyman, et al., v. Bassick,* 18 Fed. (2d) 29 CCA 6th, involving the patent here in suit).

The specific pin-fittings defined in detail in claims 14 and 15 of the patent in suit were manufactured and widely distributed by plaintiff under its other Gullborg Patent No. 1,307,733 (not in suit). At the time of trial, more than 544,000,000 of the patented pin-fittings had been sold by plaintiff (R., p. 27).

The only purpose of plaintiff's pin-fittings (just as the pin-fittings of defendants and others) is to have a grease-gun attached to them from time to time (by means of a "bayonet" type hose-coupler) so that grease may be forced into the pin-fitting from time to time.

Without a grease-gun the pin-fitting is useless.

The specific "suction-effect" grease-guns defined in detail in claims 1, 2, 3, 4 and 8 of the patent in suit were manufactured and widely distributed by plaintiff under its patent in suit. At the time of trial, more than 17,000,000 of such alleged "suction-effect" grease-guns had been manufactured and distributed by plaintiff, and were in use largely in the hands of public greasing stations and garages.

Due to plaintiff's greater commercial enterprises (its extensive advertising, etc.), and due to a large extent to plaintiff's extensive and wide-spread campaign of litigation (well over three hundred suits filed) directed largely against the rank and file of small jobbers and dealers who

could ill afford the expense of patent litigation or whose volume of business would not warrant such expense, the sale and use of "**non**suction-effect" grease-guns and the sale and use of non-infringing pin-fittings has not kept apace with the sale and use of plaintiff's "suction-effect" grease-guns and plaintiff's patented pin-fittings; with the result that plaintiff's "suction-effect" grease-guns and plaintiff's patented pin-fittings greatly outnumber the "**non**suction-effect" grease-guns and the non-infringing pin-fittings manufactured and sold by defendants and others.

It is upon this commercial situation that plaintiff's charge of *contributory* infringement must ultimately rest because,

a) except for the preponderance of plaintiff's "suction-effect" grease-guns in use, defendants' intrinsically non-infringing pin-fittings would obviously have a wide enough opportunity to be lubricated by "**non**suction-effect" grease-guns of defendants (and others), so that the present charge of *contributory* infringement of claims 1, 2, 3, 4, and 8 would not even be arguable,

and

b) except for the preponderance of plaintiff's patented pin-fittings in use, defendants' intrinsically non-infringing ("**non**suction-effect") grease-guns would obviously have a wide enough opportunity to be connected onto the unpatented and non-infringing "pin-fittings" of defendants (and others), so that the present charge of *contributory* infringement of claims 14 and 15 would not even be arguable.

In reliance upon the opinions of several Circuit Courts of Appeal which had previously passed upon the patent here in suit (*Lyman v. Bassick,* 18 Fed. (2d) 29, CCA 6; and *Alemite v. Lubrair,* 62 Fed. (2d) 899, CCA 1), and held that the claims of the patent *in* suit, in order to be valid at all, must be so limited that the defendants' herein accused devices would not even *contributorily* infringe;—the validity of the patent in suit was conceded in the lower Courts in this cause.

The District Court in its opinion (5 Fed. Sup. 940), not only held the patent valid, but also gave the claims thereof the broad interpretation theretofore condemned by the Courts of Appeal for the Sixth Circuit and First Circuit in the cases above cited and since then again condemned by the Circuit Court of Appeals for the Sixth Circuit in *Hollingshead v. Bassick,* 73 Fed. (2d) 543 (involving the same patent).

Based upon this broad interpretation of the claims of the patent in suit (which interpretation is clearly in conflict with the decisions of the Courts of Appeal for the Sixth Circuit and First Circuit), the District Court held that the sale of defendants' "**non**suction-effect" and intrinsically non-infringing grease-guns constituted *contributory* infringement of the pin-fitting claims 14 and 15 of the patent in suit, and that defendant's intrinsically non-infringing pin-fittings constituted *contributory* infringement of the "suction-effect" claims 1, 2, 3, 4 and 8 of the patent in suit.

The Circuit Court of Appeals for the Third Circuit affirmed the decision of the District Court in a *per curiam* opinion rendered on December 18th, 1934 (74 Fed. (2d) 1019).

Both the District Court as well as the Circuit Court of Appeals for the Third Circuit relied for their respective

decisions in this case upon the earlier opinion of the Circuit Court of Appeals for the Second Circuit on the same patent in the case of *Bassick v. Adams,* 52 Fed. (2d) 36.

Defendants filed a Petition for Rehearing, in which the more recent decision of the Circuit Court of Appeals for the Sixth Circuit in *Hollingshead v. Bassick* (73 Fed. 2d, 543), was again called to the attention of the Circuit Court of Appeals for the Third Circuit and the conflict between the decision of said Circuit Court and the then recent decision of the Circuit Court of Appeals for the Sixth Circuit was also pointed out.

In defendants' Petition for Rehearing it was also pointed out that this Court had previously granted a petition for writ of certiorari to the Circuit Court of Appeals for the Second Circuit in the case of *Bassick v. Adams* (52 Fed. 2d, 39);—the order of this Court granting the certiorari being reported in 285 U. S. 531.

The Petition for Rehearing was, however, denied.

REASONS RELIED UPON FOR ALLOWING THE WRIT OF CERTIORARI.

The discretionary power of this Court is invoked on the following grounds in accordance with Rule 38 of the rules of this Court:

1) the Circuit Court of Appeals for the Third Circuit has erroneously decided in effect that a patent owner having manufactured and sold a patented article may prohibit the proper and only possible use of that article by virtue of his ownership of another patent covering that article in combination with ordinary and unpatented things with which it must necessarily be used and without which that patented article would have no utility at all. This decision

involves an important question of patent law which has not been, but should be, settled by this Court.

Moreover, said decision of this question of patent law by said Circuit Court of Appeals for the Third Circuit is in direct conflict with the following decisions of other Circuit Courts of Appeal involving the patent here in suit:

Lyman, et al., v. Bassick, 18 Fed. 2d, 29 (CCA 6th);

Alemite v. Lubrair, 62 Fed. 2d, 899 (CCA 1st);

Hollingshead v. Bassick, 73 Fed. 2d, 543* (CCA 6th).

and is also in conflict with the decision of the Circuit Court of Appeals for the Sixth Circuit in the case of *Edison Electric Light Co. v. Peninsular L. P. H. Co.,* 101 Fed. 831; the decision of the Circuit Court of Appeals for the Seventh Circuit in the case of *Thomson-Houston Electric v. Illinois Tel. Constr. Co.,* 152 Fed. 631; and the decision of the Circuit Court of Appeals for the Third Circuit in the case of *General Electric Co. v. Ohio Brass Co.,* 277 Fed. 917; and also the more recent decision of this Court in *Carbice Corp. of America v. American Patents Development Corp.,* 283 U. S. 27.

2) That the Circuit Court of Appeals for the Third Circuit has erroneously decided in effect that the seller of a patented article may, by virtue of ownership of another patent covering that article in combination with the ordinary devices or things with which it must necessarily be used, impose as a condition of such sale and the right

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* The direct conflict between the decision of the Circuit Court of Appeals for the Third Circuit (74 Fed. 2d, 1019), in the case at bar and the earlier decision of the Circuit Court of Appeals for the Sixth Circuit in Hollingshead v. Bassick (73 Fed. 2d, 543), is also asserted by the respondent in the case at bar in the petition for writ of certiorari (No. 872, October Term, 1934), in the case of Bassick Mfg. Co. v. The R. M. Hollingshead Company (page 8).

to use that article in the only way in which it can be used, that such article shall not be used in combination with said devices or things sold by a competitor; and that such decision is in conflict with Section 3 of the Act of October 15, 1914, 38 Stat. L. 731, known as the Clayton Act, and is also in conflict with the decision of this Court in the case of *Carbice Corp. of America v. American Patents Development Corp.*, 283 U. S. 27.

Wherefore, your petitioners respectfully pray that a writ of certiorari be issued under the seal of this Court directed to the United States Circuit Court of Appeals for the Third Circuit sitting at Philadelphia, Pa., commanding said Court to certify and send to this Court, on a day to be designated, a full and complete transcript of the record and all proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals for the Third Circuit be reversed and that petitioner be granted such other and further relief as may seem proper.

Dated April 20th, 1935.

G. S. ROGERS (doing business as Rex Duplex Fitting Company) and
R. W. DUSENBERRY,
Petitioners.

By CHARLES M. CLARKE,
W. G. DOOLITTLE,
JAMES ROY VAN KIRK,
LEONARD L. KALISH,
Counsel for Petitioners.

The undersigned hereby certify that the foregoing petition is in their opinion well founded, and that the case is one in which the petitioners' prayer should be granted by this Court.

CHARLES M. CLARKE,
W. G. DOOLITTLE,
JAMES ROY VAN KIRK,
LEONARD L. KALISH,
Counsel for Petitioners.

BRIEF FOR PETITIONERS IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The per curiam opinion of the Circuit Court of Appeals for the Third Circuit on the appeal is reported in 74 F. (2d) 1019. The opinion of said Court on the Petition for Rehearing is unreported but is reproduced in the transcript of record filed herewith.

The opinion of the District Court is reported in 5 Fed. Supp. 940.

Jurisdiction.

The grounds on which the jurisdiction of this Court is invoked are:

1. The date of the judgment to be reviewed was December 18, 1934, and of the denial of the Petition for Rehearing January 25, 1935.

2. The judgment was rendered in a suit in equity brought under the Patent Statutes to determine the issues

of validity and infringement of Letters Patent for invention issued by virtue of Section 4886, R. S.

3. The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code, 28 U. S. C. Sec. 347, as amended by the Act of February 13, 1925.

4. Cases believed to sustain the jurisdiction are *I. T. S. Co. v. Essex,* 272 U. S. 429; *Alexander Milburn Co. v. Davis-Bournonville Co.,* 270 U. S. 390; *Concrete Appliances Co. v. Gomery,* 269 U. S. 177; *Gypsy Oil Co. v. Escoe,* 275 U. S. 498; *Carbice Corporation of America v. American Patents Development Corporation* and another, 283 U. S. 27, and also:

Lyman v. Bassick, 18 Fed. (2nd) 29 (CCA 6th);
Alemite v. Lubrair, 62 Fed. (2nd) 899 (CCA 1st);
Hollingshead v. Bassick, 73 Fed. (2nd) 543 (CCA 6th).

Statement.

The facts are sufficiently stated in the petition.

Statutes.

The statute under which this case arises and which is necessary to be considered is R. S. 4886. That statute reads as follows:

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this

or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Section 3 of the Act of October 15, 1914, 38 Stat. L. 731, known as the Clayton Act, and also involved in the cause, is as follows:

"That it shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies or other commodities whether patented or unpatented, for use, consumption or resale within the United States or any Territory thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, or fix a price charged therefor, or discount from, or rebate upon, such price, on the condition, agreement, or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale, or contract for sale or such condition, agreement, or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce."

Specification of Errors.

The errors which petitioners will urge if the writ of certiorari is allowed are that the Circuit Court of Appeals for the Third Circuit erred:

1) in holding* that claims 14 and 15 of the Gullborg patent in suit are *both* valid and are also entitled to an in-

terpretation so broad as to be contributorily infringed by petitioners' "nonsuction-effect" grease-gun, or in failing to hold that claims 14 and 15, to be valid, must necessarily be limited to the suction-effect coupler or to the suction-effect grease-gun of the Gullborg patent, and that when so limited such claims are not contributorily infringed by petitioners' "**non**suction-effect" couplers or grease-guns.

2) in holding* that claims 1, 2, 3, 4 and 8, of the Gullborg patent in suit are *both* valid and are also entitled to an interpretation so broad as to be contributorily infringed by petitioners' non-infringing pin-fitting, or in failing to hold that claims 1, 2, 3, 4, and 8, to be valid, must necessarily be limited to plaintiff's particular form of pin-fitting of the Gullborg patent, and that when so limited such claims are not contributorily infringed by petitioners' non-infringing type of pin-fitting.

3) in holding* claims 14 and 15 of the Gullborg patent in suit *broadly* valid as covering the pin-fitting element therein described in combination with **any** old type grease-gun and **any** old type coupler.

4) in holding* claims 1, 2, 3, 4 and 8, of the Gullborg patent in suit *broadly* valid as covering the "suction-effect" coupler therein described in combination with **any** old type of grease-gun and **any** old type of "pin-fitting."

5) in failing to reverse the decree of the District Court.

6) in not dismissing the Bill of Complaint for want of equity.

7) in denying petitioners' Petition for Rehearing.

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* By affirming the like holding of the District Court.

Summary of Argument.

The points of the argument follow the reasons relied upon for the allowance of the writ with a preliminary word as to the importance of the case at bar. They are also stated in the index hereto, *supra*, page i, and for the sake of brevity they are omitted at this point.

ARGUMENT.

I.

More than 544 millions of plaintiff's patented pin-fittings had been sold up to the time of the trial of this case which is indicative of the millions of automobiles that are equipped with these pin-fittings, so that the sale of every grease compressor and coupler to a public greasing station must necessarily involve the prospect that they will be used upon cars equipped with the patented pin-fittings. The number of these public greasing stations is enormous.

If by an adjudication of contributory infringement the defendant and other manufacturers of grease-guns or compressors and couplers will be barred from the sale of such equipment to public greasing stations and garages, the plaintiff will have thereby secured an additional monopoly and destroyed all competition in the sale of these unpatented grease-gun (compressors and couplers) and there will be delivered into the hands of the plaintiff the entire system of the public greasing of automobiles equipped with the patented pin-fitting, or any other pin-fittings. The dominant position of the plaintiff as a manufacturer of pin-fittings and the large number of its pin-fittings attached to

automobiles today will, if the present decision is allowed to stand, make it impossible for the manufacturer of non-infringing pin-fittings to furnish to public greasing stations any compressors and couplers to be attached to even non-infringing pin-fittings because of the likelihood that such compressors and couplers might also be used upon the patented pin-fittings and thus come within the adjudgment of contributory infringement.

II.

The Court of Appeals for the Third Circuit has erroneously decided in effect that a patent owner having manufactured and sold a patented article may prohibit the proper and only possible use of that article by virtue of his ownership of another patent covering that article in combination with the ordinary and unpatented things with which it must necessarily be used, which is an important question of patent law which has not been, but should be, settled by this Court.

Moreover, said decision of this question of patent law by said Circuit Court of Appeals is in conflict with the decision of the Circuit Court of Appeals for the Sixth Circuit in the case of *Edison Electric Light Co. v. Peninsular L. P. & H. Co.*, 101 Fed. 831, the decision of the Circuit Court of Appeals for the Seventh Circuit in the case of *Thomson-Houston Elec. Co. v. Illinois Tel. Const. Co.*, 152 Fed. 631, and the decision of the Circuit Court of Appeals for the Third Circuit in the case of *General Electric Co. v. Ohio Brass Co.*, 277 Fed. 917.

The above decisions of the Sixth and Seventh Circuits establish as a principle of patent law that the sale by a patent owner of a patented thing that is designed for and capable of use only in a combination covered in another

patent owned by the seller carries to the purchaser by necessary implication the right to use such patented thing in the only way possible, namely, in the patented combination, and the seller is estopped to assert the contrary.

In the Ohio Brass Co. case the Third Circuit Court of Appeals denied patentability, to a combination involving the use of a patented insulator with the ordinary expedients without which it could not be used, and held that there was no invention apart from that disclosed by the insulator patent itself. In the present case the only novelty that resided in the combination of the Gullborg patent No. 1,307,734 was in the separately patented pin-fitting which represented Gullborg's only contribution to the art.

The practical form in which the question is presented in the present case is the situation of a car owner whose car was equipped by its manufacturer with a set of the patented pin-fittings. Whether there was also placed in the tool box of the car at the time it was sold one of the small Alemite hand guns fitted with a coupler for attachment to the pin-fittings is not important because this car owner, in common with most car owners, prefers to have his car greased at public greasing stations where the grease is furnished from large compressors through a conduit which may be coupled to each of the pin-fittings on the car in the course of the greasing operation.

Now if the decision of the Third Circuit Court of Appeals is to prevail, in the case at bar, the car owner stands in an anomalous position. If the unpatented grease-guns (compressors and couplers) with which the greasing stations are equipped happen to be of a manufacturer other than that of the plaintiff (who owns the patent on the combination of the patented pin-fitting with the necessary pump and coupler), then both the car owner and the service station proprietor will each be infringers of the combination

patent and the manufacturer who supplied the greasing station with its compressors and couplers will be a contributor to that infringement; whereas if the greasing station proprietor had purchased his compressors from the plaintiff, then no question of infringement would be involved. In other words, the ordinary car owner is put to the duty of first finding out where the greasing station proprietor has purchased his compressor in order to determine whether he, the car owner, may make the ordinary and only possible use of the pin-fittings on his car.

In thus failing to limit the plaintiff's monopoly to the patented pin-fittings and extending it to the sale of unpatented grease-guns and couplers, which are the ordinary tools of the art and which must necessarily be used with the pin-fittings in order that they may have any utility at all, the Third Circuit Court of Appeals has awarded a monopoly not contemplated or justified by the patent law.

We are aware of no applicable decision of this Court on this precise question of patent law, but believe it to be one that should be decided by this Court.

III.

The Circuit Court of Appeals for the Third Circuit has erroneously decided in effect that the seller of a patented article may, by virtue of the ownership of another patent covering that article in combination with the ordinary devices or things with which it must necessarily be used, impose as a condition of such sale and the right to use that article in the only way it can be used that such article shall not be used in combination with said devices or things sold by a competitor; such decision is in conflict with Section 3 of the Act of October 15, 1914, 38 Stat. L. 731, known as the Clayton Act, and is also in conflict with

the decision of this Court in the case of *Carbice Corporation of America v. American Patents Development Corporation and another,* 283 U. S. 27.

It is obvious that the owner of an automobile equipped with the patented pin-fittings has a right to use them with a gun and coupler. If, as we contend, the automobile owner has acquired by reason of his purchase the free and unrestricted right to use the pin-fitting in the only way it can be used, to wit, with a coupler and a grease-gun, then the plaintiff who owns both the patent on the pin-fitting No. 1,307,733 and the patent on the so-called combination of that pin-fitting with a coupler and a gun covered by patent No. 1,307,734 could not, when once it has sold a pin-fitting and the purchaser had acquired the free and unrestricted right to use it by reason of his purchase, destroy or delimit that right because the plaintiff also owned a so-called combination patent comprising that pin-fitting and a coupler and gun with which the pin-fitting must necessarily be used.

The sale by plaintiff of separate service compressors to public greasing stations shows that the use of the pin-fitting by the car owner was not to be confined to its use in connection with the small hand gun that might be supplied with the car. The free and unrestricted right of the purchaser to use the pin-fittings at public greasing stations where the high pressure compressors could be effectively applied to them cannot be thwarted by the circumstance that the plaintiff may have caused to be placed in the tool box of the car at the time it was sold one of the small Alemite hand guns.

If the right of the car owner as the purchaser of the pin-fittings to have them combined with a service compressor and coupler at a public greasing station is dependent upon the fact that such compressor and coupler were furnished by the plaintiff, then the sale of those pin-fittings

was necessarily upon the condition that the purchaser should not use the compressors and couplers of a competitor, and hence in violation of Section 3 of the Clayton Act.

Moreover the plaintiff's large separate sales of these service compressors are with the intent and for the purpose that their purchasers will use them upon the patented pin-fittings on the cars brought to the public garages and greasing stations to be lubricated. The purchaser of a service compressor and coupler from the plaintiff is thus permitted to use them with the patented pin-fitting, whereas no such permission or license is accorded to the purchaser of these unpatented elements from a competitor; in fact, as here, the competitor is charged with contributory infringement. In other words, the sale by plaintiff of such service compressors and couplers is in effect upon the understanding that the garage man and the greasing station proprietor will not purchase and use the compressors and couplers of a competitor, such understanding being sanctioned and enforced under the lash of the patent on the combination whereby all competition in the sale of compressors and couplers for use on the widespread and separately patented pin-fittings will be effectively suppressed.

Such a limitation of the use of the pin-fittings except with guns and couplers of plaintiff's manufacture is in violation of Section 3 of the Clayton Act and obviously the fact that the plaintiff has gotten a patent on the combination with the pin-fitting of a coupler and compressor does not relieve the plaintiff from the charge of undertaking to control, in violation of law, the purchase and sale of the expedients which must necessarily be employed in connection with the pin-fitting.

In *Lord, et al., v. Radio Corp. of America* (C. C. A. 3, 28 F. (2d) 257; certiorari denied, 278 U. S. 648), it was held that the condition for a license under a combination

patent that the licensee should purchase one of the elements from the licensor was void and unenforcible as being in violation of Section 3 of the Clayton Act. So also in the present case, a condition that a car owner or the proprietor of a greasing station must purchase the gun and coupler from the plaintiff in order to get the right to inject grease into the patented pin-fittings is likewise void and unenforcible as being in violation of Section 3 of the Clayton Act. As the Third Circuit Court of Appeals said in that case (page 260):

> "The inclusion in a patented combination of an unpatented element does not give the patentee of the combination a monopoly of each element and the exclusive right to make, use and sell that element independent of the combination."

In other words, claims 14 and 15 of the patent in suit do not give the plaintiff here the exclusive right to make and sell to garages and public greasing stations the unpatented grease-guns and coupler elements of the patented combination.

Moreover the decision of the Third Circuit Court of Appeals in the case at bar, in the present case is in conflict with this Court's decision in the Carbice case (*supra*). In that case the patent was on a transportation package consisting of a protective casing of insulating material with solid carbon dioxide and a freezable product arranged in a certain relative position therein. The owner of the patent was engaged in the sale of solid carbon dioxide and restricted the use of such a package to those who purchased the carbon dioxide element from it. The case arose upon the charge of contributory infringement against the defendant who had sold solid carbon dioxide for use in a transportation package like that described in the patent and this Court held that the patent owner could not use its patent

as a basis for compelling the purchase from it of one of the unpatented elements embraced within the patent claim, citing *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425.

This Court in its decision in the Carbice case has denied the attempted distinction between its earlier decision in the Morgan Envelope case in which the element furnished by the alleged contributory infringer was a passive element or in the nature of supplies and the Carbice case where the solid carbon dioxide was a dynamic element, holding that these distinctions are without legal significance and that the patent owner has no right to control the use of unpatented materials even though an element of a patented combination. So also in the present case the sale of the unpatented compressor and coupler cannot be monopolized by the owner of the combination patent and made a condition for the rightful use of the patented pin-fitting so that all manufacturers of grease compressors and couplers will be excluded from a market which will involve the application of grease from an ordinary grease-gun or compressor through a Gullborg patented pin-fitting.

IV.

The Circuit Court of Appeals for the Third Circuit (as well as the District Court which it affirmed) has erroneously given the claims of the patent in suit a scope greater than the asserted invention, by holding on one hand that claims 1, 2, 3, 4 and 8 cover* any **old** (or new) grease-cup or "pin-fitting" regardless of its construction, if such **old** (or new) grease-cup or "pin-fitting" is momentarily coupled with, connected to, or lubricated by plaintiff's "suction-effect" grease-gun as defined in these claims, and

by holding on the other hand, that claims 14 and 15 cover* any old (or new) grease-gun, regardless of its construction (and including "nonsuction-effect" grease-gun) if such old (or new) grease-gun is momentarily coupled with or connected to plaintiff's patented "pin-fittings" forming the subject of its earlier-filed patent 1,307,733 not in suit;—in direct conflict with the following decisions of the other Circuit Courts of Appeals adjudicating the patent here in suit:

Lyman, et al., v. Bassick, 18 Fed. 2nd, 29 (CCA 6);
Alemite v. Lubrair, 62 Fed. 2nd, 899 (CCA 1);
Hollingshead v. Bassick, 73 Fed. 2nd, 543 (CCA 6).

The Court of Appeals for the Sixth Circuit in *Lyman, et al., v. Bassick,* 18 Fed. 2nd, 29, adjudicated the patent here in suit against a series of six separate defendants in six separate suits, some of which defendants were making "pin-fittings" of plaintiff's specific patented construction, and some of which were making grease-guns with the so-called "suction-effect" couplers. The Court of Appeals for the Sixth Circuit in that decision (though sustaining the claims of the Gullborg patent here involved) clearly indicated that claims 14 and 15 of the Gullborg patent were valid only if limited, by construction, to the "suction-effect" grease-gun disclosed in the Gullborg patent and that the claims 1, 2, 3, 4 and 8 were valid only if limited, by construction, to plaintiff's specific "pin-fitting" construction also disclosed in the Gullborg patent.

In that case (*Lyman, et al., v. Bassick*) a broader construction of the Gullborg claims was not necessary or required because the defendants there had appropriated the gist of plaintiff's alleged contribution to the old grease-gun, to wit, the "suction-effect" coupler and had also appropri-

*On a theory of "contributory" infringement.

ated plaintiff's alleged contribution to the old "pin-fitting," to wit, the peculiar disposition of the valve-closing spring between the valve-closure and the bayonet-pin.

Based chiefly upon a misconstruction of the opinion of the Court of Appeals for the Sixth Circuit in *Lyman, et al., v. Bassick,* 18 Fed. 2nd, 29, though in an apparent effort to follow that decision of the Sixth Circuit Court of Appeals, some other courts have since rendered decisions which are, in fact, in conflict therewith;—influenced, no doubt, by the fact that plaintiff urged or argued a misinterpretation of said opinion the Court of Appeals for the Sixth Circuit in *Lyman, et al., v. Bassick, supra.*

Plaintiff's misinterpretation of the original opinion of the Court of Appeals for the Sixth Circuit in *Lyman, et al., v. Bassick,* was made possible by the fact that six different suits were determined by this one appellate opinion, and by the further fact that after the mandates went down some of the defendants (for reasons unknown) consented to the entry of decrees in the District Court enjoining not only "suction-effect" grease-guns and infringing "pin-fittings," but enjoining also "non-suction-effect" grease-guns and non-infringing "pin-fittings" on a broader construction of the claims and on the theory of contributory infringement since then advanced by plaintiff in this and many other suits.

It was upon the strength of these final decrees in the District Courts (following a mandate) that the opinion of the Court of Appeals for the Sixth Circuit was successfully misconstrued by plaintiff in subsequent suits in which the Courts endeavored to follow said original appellate opinion of the Sixth Circuit or the opinion of some other Court which previously had followed said original opinion of the Sixth Circuit.

That the original opinion of the Court of Appeals for

the Sixth Circuit in *Lyman, et al., v. Bassick,* 18 Fed 2nd, 29, was not intended to be construed as plaintiff had urged in many courts thereafter, is evident from the more recent decision of the same Circuit Court of Appeals in *Hollingshead v. Bassick,* 75 Fed. 2nd, 543, wherein there were no defendants' "pin-fittings" involved at all, but in which there were involved two defendants' "**non**suctional" grease-guns (different from each other in detailed construction, however), and as to one of which "**non**suction-effect" grease-guns plaintiff conceded the "**non**suctional" character and charged infringement **only** of claims 14 and 15 which do not by their bare language recite the "suctional" feature.

In the recent decision of the Court of Appeals for the Sixth Circuit in *Hollingshead v. Bassick, supra,* that Court of Appeals clearly held that claims 14 and 15 in order to be valid must necessarily be limited to the "suction-effect" grease-guns or to grease-guns with a "suction-effect" coupler of the kind shown in the Gullborg patent, the clear inference being that unless so limited these claims are necessarily invalid as involving no invention.

Plaintiff in its petition for writ of certiorari to this Court in said Hollingshead case which petition is now before this Court (under docket number 872 of the October Term, 1934), has **not** petitioned this Court to review that part of the decision of the Court of Appeals for the Sixth Circuit which has so limited claims 14 and 15 but has confined its petition for writ of certiorari wholly to a factual question relating to the Hollingshead's other grease-gun involved in said Hollingshead suit, to wit, whether said other grease-gun was, in fact, of the "suctional" or "**non**suctional" character.

By so avoiding this question as to the scope of claims 14 and 15, as now again determined by the Court of Ap-

peals for the Sixth Circuit (in its petition for writ of certiorari to this Court), plaintiff has conceded the correctness of the decision of the Court of Appeals for the Sixth Circuit in *Hollingshead v. Bassick,* 73 Fed. 2nd, 543, as to the limitations which must be imposed upon the scope of claims 14 and 15 in order that they may be valid.

The Court of Appeals for the Sixth Circuit in *Hollingshead v. Bassick,* 73 Fed. 2nd, 543, did not have before it for consideration any defendant's "pin-fittings", and, therefore, that Court was not required to and, therefore, did not determine that same question of law with respect to claims 1, 2, 3, 4 and 8. There can be no doubt however that the same principle of law is applicable to both groups of claims, and that if the Court of Appeals for the Sixth Circuit had had before it also a non-infringing "pin-fitting" on a charge of contributory infringement of the "suction-effect" grease-gun claims 1, 2, 3, 4 and 8, it would undoubtedly have likewise held that these claims must likewise be limited to plaintiff's specific "pin-fitting" construction, or that they are not infringed by a "pin-fitting" construction not embodying those structural features of "pin-fitting", in which plaintiff's asserted grease-cup novelty resides.

The Court of Appeals for the First Circuit in *Alemite v. Lubrair,* 62 Fed. 2nd, 899, reached a conclusion substantially the same as that reached by the Court of Appeals for the Sixth Circuit, that is, that the combination claims 14 and 15 are either limited to plaintiff's "suction-effect" grease-gun or if broadly construed are invalid.

The Court of Appeals for the First Circuit also clearly pointed out the conflict between plaintiff's broader contention and the Clayton Act and the decisions of this Court in the Carbice case, *supra,* and in the *United Show Machinery Corporation v. United States* case, 252 U. S. 451, 465,

and the decision of the Court of Appeals for the Third Circuit in *Lord v. Radio Corporation,* 28 Fed. 2nd, 257.

Subsequent to the decision of the Court of Appeals for the First Circuit in *Alemite v. Lubrair,* 62 Fed. 2nd, 899, the defendant in that case, for reasons unknown, consented to a mandate and to a final decree holding claims 14 and 15 infringed by the **non**suctional grease-guns which in the published opinion for the Court of Appeals for the First Circuit were held **not** to infringe these claims.

This court granted a writ of certiorari to the Court of Appeals for the Second Circuit in *Bassick v. Adams,* 52 Fed. 2nd, 36, (CCA 2);—the one appellate opinion which clearly sustained plaintiff's broad contentions in the case at bar. Plaintiff settled this case out of court and the successful petitioner in that cause thereupon withdrew its appeal.

In conclusion it is submitted that the decisions of the Courts of Appeals for the Sixth Circuit and the First Circuit above referred to were correct and well founded, and the correctness of such decisions is in effect conceded by plaintiff by:

a) plaintiff's failure to raise the question of the scope of claims 14 and 15 in its recently filed petition in this Court for writ of certiorari to the Court of Appeals for the Sixth Circuit in the case of *Hollingshead v. Bassick* (*supra*)

b) plaintiff's failure to petition this Court for a writ of certiorari in the case of *Alemite v. Lubrair,* 62 Fed. 2nd, 899, and its apparent settlement of that case out of court.

c) plaintiff's disinclination to permit the same question to be reviewed by this Court in the case of *Adams v. Bassick,* 285, U. S. 531.

CONCLUSION.

From the foregoing, it appears that the Court of Appeals for the Third Circuit has rendered a decision of such a nature as to justify the issuance of a writ of certiorari for its review and one which has seriously prejudiced the rights of your petitioners.

Respectfully submitted,

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